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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,906	03/09/2004	Masami Suzuki	12587-048001 / D03-047/01	3382
26212 7590 09/22/2008 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			NOTIFICATION DATE 09/22/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/797,906	Applicant(s) SUZUKI ET AL.	
	Examiner JASON B. DUNHAM	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 9-10, 12, 14-16, 20-21, and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9, 10, 12, 14-16, 20, 21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/26/07, 12/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amended claims 1, 3, 7, 10, 14, 20, 23, and 26, canceled claims 6, 8, 11, 13, 17-19, and 22, and added claims 27-37 in the response filed November 20, 2007. Claims 1-5, 7, 9-10, 12, 14-16, 20-21, and 23-37 are pending. Applicant's petition filed October 26, 2007 was granted and the previous 35 USC 102(e) rejection in view of Williams (2005/0197946) is vacated.

Election/Restrictions

Newly submitted claims 30-37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 30-37 are directed towards methods for producing recommendations for improving sales performance when performance declines from a prior time period.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-16, 20-21, and 23-25 are rejected under 35 U.S.C. 101.

Referring to claims 14-16, 20-21, and 23-25. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function

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of the descriptive material to be realized. Independent claim 14 fails to recite a “software tool” that is embodied on a computer-readable medium and acted upon by a processor. The claim is merely directed to a computer program per se.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 recites the limitation "the one or more sales targets". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 9, 12 and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang (US 2003/0154134).

Referring to claim 1. Wang discloses a computer-implemented method comprising:

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- Receiving information describing one or more items for sale by a seller (Wang: figure 1);
- Facilitating a sale of the items through one or more online sales channels (Wang: abstract); and
- Processing the received information and data associated with the facilitated sale using a data warehouse analytical processing tool to generate metrics to report to the seller (figure 5);
- Reporting to the seller organized groups of metrics in a dashboard (Wang: figure 5).

The examiner notes that the contents of the dashboard are non-functional descriptive material. Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate- In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II. There is no functional relationship between the display of output information (i.e. top-line and bottom-line highlights) and processing the received information.

Referring to claim 2. Wang further discloses a method wherein an item comprises a good (Wang: abstract).

Referring to claim 9. Wang further discloses a method comprising keeping track of information related to the one or more items for sale, wherein the information

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comprises financial information and quantity of goods sold, wherein the financial information comprises fees and costs (Wang: figure 5).

Referring to claim 12. Wang further discloses a method comprising receiving business specific information (Wang: figure 5).

Referring to claims 26-29. Claims 26-29 is rejected under the same rationale set forth above in the rejection of claim 1 as the claims contain limitations directed towards non-functional descriptive material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 7, 10, 14-16, 20-21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US 2003/0154134) in view of Jin (US 2005/0033648).

Referring to claims 4-5, 7 and 10-11. Wang discloses all of the above as noted under the 102 (e) rejection including providing a software infrastructure that enables the seller to provide information describing one or more items to be sold on the one or more online sales channels (Wang: abstract) but does not expressly disclose recommendations to improve the sale price of items and comparing actual sales to sales targets. Jin discloses a method comprising:

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- the reporting provides the seller with a central source for measuring and assessing information including sales targets determined by the seller (Jin: figure 6 and paragraph 83);
- Recommendations to improve item sale prices (Jin: abstract);
- Feedback on a condition of sales in comparison to sales targets (Jin: figure 5), determined by the seller (Jin: figure 5);
- Reporting metrics facilitates sales adjustments response to an auction (Jin: figure 8).
- Recommendations on sales showing cause and effect patterns (Jin: figure 10), the recommendations and reporting metrics based on the seller's preferences (Jin: figures 5 and 7).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Wang to have included recommendations to improve the sale price of items and comparing actual sales to sales targets, as taught by Jin, in order optimize seller's returns based on seller created rules (Jin: abstract).

Referring to claims 14-16, 20-21, and 23-25. The combination of Wang and Jin further discloses a system comprising:

- A processor to process data related to a plurality of items for sale by a seller on an online sales channel, the processor configured to generate metrics associated with a sale of the plurality of items (Wang: paragraphs 13-15 and figure 5). A server would inherently contain a processor.

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- A software tool to organize and present the metrics to show interrelationships of sales activities and cause and effect patterns of sales performance, the software tool being configured to generate reports (Jin: figures 5-6). The examiner notes that the contents of the dashboard are non-functional descriptive material.

Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.

The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate- In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II. There is no functional relationship between the display of output information (i.e. top-line and bottom-line highlights) and processing the received information.

- A software tool configured to allow the seller to assess the performance of sales relative to specified targets (Jin: figure 6 and paragraph 83), wherein the tool comprises self-servicing functionality to allow the seller to access information at the seller's convenience (Jin: figure 6)
- A software tool further configured to facilitate organized views of auction data (Jin: figure 6) in a web based format (Jin: paragraph 10) showing gross sales (Jin: figure 6).

Response to Arguments

Applicant's arguments filed November 20, 2007 regarding the above claims have been fully considered but they are not persuasive. The examiner disagrees with Applicant's summary of the interview as contained within the remarks. As noted on the interview summary dated November 13, 2007, suggestions for possible amendments to independent claim 1 that would add functionality to the display of information were made by Examiner Gart. These suggestions have not been incorporated into the claims. Please note the above rejections discussing non-functional descriptive material. Furthermore, no indication was given by the examiners during the interview as to limitations that would define over the prior art as alleged in page 1 of the remarks.

Applicant argues that Wang does not disclose "top-line highlights, bottom-line highlights, SKU-level information, and an executive summary." Applicant repeats similar arguments and further notes the displayed "subjective information" regarding the rejections in view of the combination of Wang and Jin. The examiner notes the rejection above indicating that this information is merely displayed and is non-functional descriptive material. Newly added claims 27-29 further contain limitations merely directed towards the display of non-functional descriptive material. Newly added claims 30-37 are directed to a distinct invention as noted above in the election/restriction section and are accordingly withdrawn from consideration.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
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JBD
Patent Examiner
9/3/08